

Appl. No. : 10/642,952  
Filed : August 18, 2003

### REMARKS

Claims 1-12 have been canceled merely as being directed to a non-elected invention. Solely for the present application, Claims 13 and 24 have been amended by incorporating the limitations of Claims 18, 21-23, 29, and 32-34, respectively, and further by limiting the pore volume to no less than 0.125 mL/g which was suggested by the Examiner. Claims 18, 21-23, 29, and 32-34 have been canceled without prejudice. Applicant reserves the right to prosecute the canceled claims in a continuing or divisional application. No new matter has been added, and no new issue has been raised. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

#### Election/Restriction

Claims 1-12 have been withdrawn from consideration as being directed to a non-elected invention. Claims 1-12 have been canceled.

#### Rejection Under 35 U.S.C. § 112, first paragraph

Claims 21 and 24-34 have been rejected under 35 U.S.C. § 112, first paragraph. Claims 13 and 24 have been amended to incorporate the limitations of Claims 18, 21-23, 29, and 32-34, respectively, which have been canceled without prejudice.

The Examiner asserts: "the specification does not support having a pore volume of less than 0.125 mL/g (see specification page 11, lines 3-11)." However, as the specification clearly states "for example" (page 11, lines 5-6), "0.125 mL/g" is merely an example and is not intended to limit the scope of the claims. However, considering that this is in response to the final office action, Claims 13 and 24 have been amended to include "no less than 0.125 mL/g", thereby obviating this rejection.

The Examiner further asserts: "a conversion ratio of methanol to dimethyl ether is new matter." However, the specification explicitly states "a conversion ratio of methanol to DME" (page 15, lines 11 and 21, page 16, lines 6 and 22, page 17, lines 4, 13, and 22, page 18, lines 5 and 14). Further, in any event, as the footnote to Table 1 (page 20) reads "no components other than DME, water or unreacted methanol were detected," the difference between the amount of methanol

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fed and the amount of unreacted methanol is substantially the same as the amount of DME. Thus, the phrase is not new matter. Applicant respectfully requests withdrawal of this rejection.

Rejection Under 35 U.S.C. § 112, second paragraph

Claims 24-34 have been rejected under 35 U.S.C. § 112, second paragraph, with regard to "conversion ratio". As the Examiner suggests, the phrase have been amended to "a conversion ratio of methanol to produce dimethyl ether", thereby obviating this rejection.

Rejection Under 35 U.S.C. § 102 Based on Inomata

Claims 13-21 and 24-31 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Inomata (note that the Examiner erroneously refers to this reference as "Imata"). Claims 13 and 24 are independent. The limitations of Claims 22-23 and Claims 33-34 which have not been rejected on this ground have been incorporated into Claims 13 and 24, respectively. Thus, Claims 13 and 24 as amended herein could not be rejected on this ground. Applicant respectfully requests withdrawal of this rejection.

Rejection Under 35 U.S.C. § 102 Based on Brake

Claims 13-17, 19-28, and 30-34 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Brake. Claims 13 and 24 are independent. The limitations of Claim 18 and Claim 29 which have not been rejected on this ground have been incorporated into Claims 13 and 24, respectively. Thus, Claims 13 and 24 as amended herein could not be rejected on this ground. Applicant respectfully requests withdrawal of this rejection.

Rejection Under 35 U.S.C. § 103

Claims 13-20, 22-31, 33, and 34 have been rejected under 35 U.S.C. § 103(a) as obvious over Inomata. Claims 13 and 24 are independent. The limitations of Claim 21 and Claim 32 which have not been rejected on this ground have been incorporated into Claims 13 and 24, respectively. Thus, Claims 13 and 24 as amended herein could not be rejected on this ground. Applicant respectfully requests withdrawal of this rejection.

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Response to the sections of "Response to Amendment" and "Response to Arguments"

The Examiner concludes that the Inomata catalyst did not contain sodium oxide, absent evidence to the contrary. However, as the Examiner correctly states, inherency requires necessary consequence, not probabilities or possibilities. As shown in the declaration previously submitted, even though the content of sodium oxide was adjusted by either selecting low-Na content raw materials or conducting acid washing (page 1, 4th to last line), the catalyst still contained sodium oxide (see the table on page 2). Inomata does not show any special process to reduce the content of sodium oxide, and thus, one of ordinary skill in the art could not fairly reach the conclusion that the Inomata catalyst contained no sodium oxide. In Inomata, there is nothing showing that no sodium oxide is necessarily present. There is nothing showing that no sodium oxide is even probably or possibly present.

**CONCLUSION**

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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